

REMARKS

Claims 1-18 are pending in the application, with Claims 1, 6, 10, 13, and 16 being independent claims. Claims 1, 6, 10, 13 and 16 have been amended and new Claims 17-18 have been added. No new matter is added by these amendments.

ARGUMENTS

Claims 1-16 stand rejected as being obvious in light of US 4,233,689 (Baron) and US 3,878,563 (Pulju). Reconsideration of this rejection is respectfully requested in light of the amendments above and the arguments below.

The independent claims recite a pair of masking layers having lamps positioned therebetween and eye holes defined therein. The Examiner suggests that it would be obvious to combine the disclosure of Baron with the eye holes of Pulju to enhance visibility. It is respectfully submit that one would not look to modify protective headgear for martial arts practice with a mask intended for protection from the cold, to derive the mask as presently claimed. As explained below, protective headgear for use in martial arts practice has significantly different characteristics and performance requirements than a mask intended for protection from cold, and these different characteristics and performance requirements lead to different structures that, if combined, are counterproductive for the intended purposes of the original device.

Baron discloses protective headgear 10 having an inner transparent shell 12 and a pair of transparent, flexible sheets 14, 14' sealed to the inner shell, forming a shock-absorbing air chamber 16 about the inner shell. The protective headgear would thereby protect both the wearer, and a training partner or student striking the wearer, during self-defense and/or martial arts training. Pressure activated switches are disposed on the inner shell at various locations corresponding to vital target areas, including switches 60 and 62 disposed over the wearer's eyes. Baron specifically recites the example of a blow being delivered by a person's fingers to the headgear in column 6, lines 48-52. It would be apparent to those skilled in martial arts that the area of the protective headgear surrounding switches 60 and 62 and the eyes must be constructed of material which will not only protect the wearer, but will also protect the relatively easily injured fingers of a training partner.

Pulju discloses a mask that is intended to provide protection from cold temperatures during activities such as snowmobiling. The mask includes a body 10 having openings 20-22 defined therein to accommodate the eyes, nose and mouth. A flexible skirt 25 covers the nose opening 21

and mouth opening 22, directing exhaled air downward and away from any glasses or goggles that might be worn by wearer. Only the lower portion of the Pulju mask has multiple layers. The eye openings are positioned in a single layer and there is no registration between openings for the mouth and/or nose with the associated second layer.

The Office Action asserts that Baron could be modified to include the eye holes of Pulju. However, such a modification would make Baron significantly less suitable for martial arts training and would not fully prevent finger strikes towards the wearer's eyes. Thus, this modification would be contrary to the intended use of Baron. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01 (citing *in re Gordon*, 733 F. 2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). Applicants respectfully submit that modification of Baron by including the eye holes of Pulju (with or without some sort of screen) would make Baron unsuitable for its intended purpose and that, therefore, these references cannot be properly combined. Manifestly, Claim 1 is not suggested nor disclosed by the cited references, nor are the other claims having this structural combination.

The Office Action further asserts that the Baron structure, modified with eye openings in Pulju, could be further modified with a screen, such as screen 44 covering the mouth in Baron. The most relevant definitions of a screen are "something that serves to divide, conceal, or protect . . . a coarse sieve used for sifting of fine particles . . . a window insertion of framed wire or plastic mesh used to keep out insects . . . " American Heritage Dictionary, Second College Edition, p. 1102 (1985). Based on this definition, and the purpose of the various apertures discussed in the Office Action, the Applicants submit that a rigid screen covering the breathing hole in Baron does not suggest the application of a screen to cover eye holes in a mask that would permit the wearer to see therethrough. A screen that is structured to prevent entry of a finger into the aperture during marital arts training is likely not appropriate for covering an eye opening.

Baron is silent about the size of the breathing aperture that is covered by the screen 44. The location of the screen 44 in the unmodified Baron is over the wearer's mouth, a location wherein it would not be subject to finger strikes, but would instead be subject to punches, palm heel strikes, elbow strikes, etc., all of which present a significantly larger cross-sectional area on the striking surface than a finger strike. Such a strike towards the screen 44 of the unmodified Baron could

potentially be at least partially absorbed by the shock absorbing chamber 16 surrounding the breathing aperture. A finger striking a screen 44 would not be the result of a direct finger strike, but would more likely be the result of a finger that is loosely extended during a palm heel strike to the chin, in which case the vast majority of the force delivered by the strike would be absorbed by the portion of the mask coming in contact with the palm heel, not the screen 44. Therefore, Baron contains nothing to suggest that the air hole screen is suitable for covering eye holes in Baron and to permit visibility therethrough. The fact that Baron includes a solid cover for the eyes suggests only that the screen is not suitable (and thus is contrary to the claimed invention).

The structure of the screen of the present invention is particularly recited in Claims 6 and 13, which specify that the screen material permits visibility therethrough and resists viewing of the wearer's face and eyes positioned behind the eye openings. Claims 17 and 18 further specifically recite that the screen is a woven fabric having sufficient openings to permit the wearer to see out. As explained in paragraph 23 of the Specification, this screen, in combination with the darkness behind the mask, creates a shadow of the eyes to resist viewing of the eyes. Baron and Pulju are protective face masks and do not suggest or disclose any desirability of restricting viewing of the wearer's eyes. Baron discloses a screen 44 made from nylon covering a rigid breathing hole structure, but does not disclose that the apertures and structures defined would be suitable for permitting vision therethrough.

Claim 10, 13 and 16 also recite that the outer masking layer permits viewing the lights when they are activated, but hides the lamp structures and electrical connections. Claims 10 and 13 recite that the outer masking layer is made of a translucent material. Baron does not disclose that either layer is anything but transparent. In fact, Baron states the desirability making the lamp structures visible so that the wearer and the training partner can see the strikes, which activate a light. Nothing within Pulju supplements the disclosure of Baron to provide a translucent outer layer or an outer layer that hides a lamp structure, while permitting viewing of a lighted lamp.

Claims 10, 13 and 16 specifically recite that the inner masking layer is opaque. As explained in paragraph 23 of the Specification, an opaque inner layer resists any tendency of the light to pass through the inner layer, which could distract the wearer or illuminate the wearer's facial surfaces. Baron discloses a transparent inner shell 12, which would not resist the passage of light from LED's 110 and 111 through to the interior of the mask, where it could be viewed by the wearer of the mask.

Nothing within Baron discloses any desirability of resisting the passage of light into the interior of the mask.

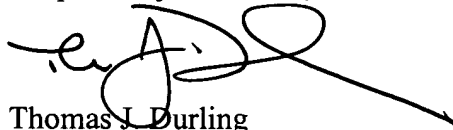
Pulju discloses a mask made from a layer of nylon fabric, an intermediate insulating layer 13 of foam, and a relatively air-impervious outer lining 11 which is vinyl fabric. Pulju, column 5, lines 35-40. Although the face mask of Pulju is admittedly opaque, nothing from Pulju suggests the use of a lighted structure with the mask. It is respectfully submitted that one skilled in the art would not be motivated to modify Baron with the opaque components of Pulju.

Obviousness can only be established by combining or modifying the teachings of the prior art when there is some teaching, suggestion or motivation to do so. This motivation must be found either explicitly or implicitly in the references themselves. The cited references do not suggest anything about the desirability making a mask having the claimed features. One skilled in the art would not be motivated by the references, directed to protective masks for different purposes, to create the decorative mask as claimed. The modifications to the prior art proposed in the Office Action are contrary to the intended purpose of the references. Manifestly, the claims are not suggested by these references or the other art of record.

It is respectfully submitted that Baron cannot be combined with Pulju to produce the recitations of Claims 1-18 and that these claims are therefore in condition for allowance.

For the above reasons, it is respectfully submitted that the application is in condition for allowance. If any minor issues remain which could be resolved by a telephone call, the Examiner is invited to telephone Applicants' representative.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas J. Durling', with a long horizontal line extending to the right.

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